

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:	:	Group Art Unit: 2445
John Fred Davis et al.	:	Examiner: Ryan J. Jakovac
Serial No.: 10/796,161	:	IBM Corporation
Filed: 03/09/2004	:	Intellectual Property Law
Title: SYSTEM, METHOD AND COMPUTER	:	Department SHCB/040-3
PROGRAM TO BLOCK SPAM	:	1701 North Street
Confirmation No. 3025	:	Endicott, NY 13760

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Request For Rehearing Under Rule 41.52

This is a request for rehearing of the Board Decision of March 29, 2012.

Claims 1-16 and 21-28 were rejected under 35 USC 103(a) based on Kirsch (US Patent Application 2004/0177120) in combination with Spamhaus ("The Spamhaus Project", December 11, 2001).

Claim 1 recites a method of blocking unwanted e-mails. A determination is made that an e-mail is unwanted. A source IP address of the unwanted e-mail is determined. A registrant of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, and **in response**, subsequent e-mails from the other IP addresses are blocked.

In contrast to present claim 1, Kirsch (US Patent Application 2004/0177120) does not teach that a registrant of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, and **in response**, subsequent e-mails from the other IP addresses are blocked.

Rather, Kirsch (US Patent Application 2004/0177120) discloses that the true sender of an e-mail message is identified based on data **in the e-mail message** and then the reputation, or rating, of the true sender is assessed to determine whether to pass the e-mail message on to the recipient. The Examiner acknowledges the broad deficiency of Kirsch (US Patent Application 2004/0177120), "Kirsch does not expressly disclose determining other source IP addresses owned or registered by an owner or registrant of the source IP address of said unwanted e-mail." So, the Examiner cited Spamhaus to purportedly fill the gap of Kirsch.

Before discussing Spamhaus, note that the Examiner ignored the recitation in claim 1 that **in response to** querying an entity that manages registration of IP addresses to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, subsequent e-mails **from the other IP addresses** are blocked. In other words, claim 1 recites that these other source IP addresses are blocked based on their registration by the spammer irrespective of whether spam was sent from these other source IP addresses. This is not taught or suggested by Spamhaus. Spamhaus states that individual IP addresses of spammers are identified and put in a list, but there is no teaching in Spamhaus of the feature of claim 1 where a registrant of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, and **in response, subsequent e-mails from the other IP addresses are blocked.**

Points Misapprehended or Overlooked by Board

1. The Board found that Spamhaus teaches or suggests an entity that manages registration of IP addresses to determine other source IP addresses registered to a registrant. However, the Board overlooked a key element of claim 1 which states that **in response to** querying an entity that manages registration of IP addresses to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, subsequent e-mails **from the other IP addresses** are blocked. The Board overlooked this recitation in claim 1 that these other source IP addresses of the spammer are blocked based on their registration by the spammer irrespective of whether spam was sent from these other source IP addresses. This is a key feature of claim 1!
2. The Board cited as a reason to affirm the rejection that Appellant did not file a Reply Brief.

Appellant's Argument To Points Misapprehended or Overlooked by the Board

1. Claim 1 states that the decision of which IP addresses to block is **responsive to** the results from the query to the entity that manages registration of IP addresses to identify the **other source IP addresses of the spammer**, (irrespective of whether the spammer has sent spam from these other source IP addresses). This is not taught or suggested by the prior art. As explained in the Appeal Brief, "Spamhaus states that individual IP addresses of spammers are identified and put in a list, but there is no teaching of the feature of claim 1 where a registrant of the source IP address of the unwanted e-mail is determined, and an entity that manages registration of IP addresses is queried to determine other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail, and **in response**, subsequent e-mails from **the other IP addresses** are blocked (irrespective of whether the spammer has sent spam from these other source IP addresses). **Spamhaus does not obtain the other source IP addresses of the spammer in this manner, and neither the Board nor the Examiner has proffered such a teaching from Spamhaus.** In other words, the Board overlooked this

recitation in claim 1 that these other source IP addresses of the spammer are blocked based on their registration by the spammer irrespective of whether spam was sent from these other source IP addresses. Every limitation of a claim carries weight to overcome the prior art, and the Board should consider this **key** limitation of claim 1, which it did not.

2. The Appeal Brief addressed all of the Examiner's arguments made in the Answer Brief, so there was no need to file a Reply Brief. The pivotal issue is whether Spamhaus teaches that **in response to** querying an entity that manages registration of IP addresses to determine **other source IP addresses registered to the registrant of the source IP address of the unwanted e-mail**, subsequent e-mails from **the other IP addresses** are blocked. The Appeal Brief addressed this issue as explained above. The Board did not even identify a new, pertinent argument made by the Examiner in the Answer Brief that was not addressed in the Appeal Brief. Also, Rule 41.41 states that a Reply Brief is optional.

Based on the foregoing, Appellants request that the rejection of claims 1-16 and 21-28 under 35 USC 103(a) based on Kirsch and Spamhaus be reversed.

Respectfully submitted,

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